

Express Mail No. EV 456 921 187 US
Attorney Docket No.: 018781-010110US (11134-077-999)
CAM No.: 893053-999077

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Burkitt *et al.*
Serial No. : 10/666,857
Filed : September 19, 2003

Art Unit : 1626
Examiner : Anderson, Rebecca
Conf. No. : 5761

Title : Antiinflammation agents

RESPONSE TO RESTRICTION REQUIREMENT

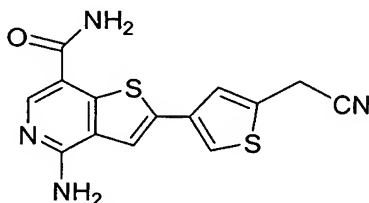
Mail Stop Amendment.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants have carefully considered the Restriction Requirement mailed October 25, 2005. Submitted herewith is a Petition For Extension of Time under 37 C.F.R. § 1.136(a) extending the period for response by one (1) month to and including December 25, 2005, with the appropriate fee.

In response to the Restriction Requirement, Applicants elect to prosecute the claims of Group I (Claims 1-32 and 35).

The PTO has further required the election of a single compound. In response, Applicants elect the following compound:



Applicants note that the compound is disclosed in the application at, for example, Figure 6. The PTO has additionally required that the election of the single compound include an exact definition of each substitution on Formula(I) selecting a single member at each substituent group or moiety. Applicants note that Formula(I) of Claim 1 encompasses the elected compound when W is a 5-6 fused bicyclic ring system, R¹ is -CONR^{1a}R^{1b}, R² is -NR^{2a}R^{2b}, L is single bond, Q is heteroaryl, wherein Q is optionally further substituted, and each R^{1a}, R^{1b}, R^{2a} and R^{2b} is hydrogen.

Applicants reserve the right to pursue non-elected subject matter in one or more later filed divisional, continuation, or continuation-in-part applications.

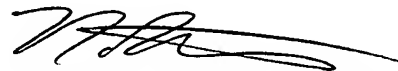
The PTO states that the PTO will determine the scope of "independent invention" and provide a clear statement of the examined invention in the first action on the merits. According to the PTO, the Restriction Requirement may be made final at that time.

Since Applicants have yet to review the actual Restriction Requirement and it might be made final *before* Applicants' review, Applicants hereby traverse the instant Restriction Requirement. The instant Restriction Requirement provides no scope of invention for the Applicants to elect; rather, it is an invitation for the PTO to provide later the scope of "independent invention" for examination. Applicants remind the PTO that the standards for Restriction practice are provided in *In re Weber*, 198 USPQ 328, 331 (CCPA, 1978) ("As a general proposition, an applicant has a right to have *each* claim examined on the merits... If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification." Emphasis in original.)

Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested.

No fee in addition to the one month extension fee is believed to be due with this response. However, if it is determined that fees are due, please charge them to Jones Day Deposit Account No. 503013 (order no. 893053-999077).

Respectfully submitted,



Date: December 22, 2005

Rahul Pathak (Reg. No. 42,983)
For: Anthony M. Insogna (Reg No. 35,203)
Jones Day
12750 High Bluff Drive
Suite 300
San Diego, CA 92130
(858) 314-1130 – direct
(858) 314-1150 – fax
ainsogna@jonesday.com